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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,068	10/13/1999	TAKEHIRO YOSHIDA	862.3067	6943
5514	7590	12/16/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WALLERSON, MARK E	
		ART UNIT	PAPER NUMBER	
		2626		
DATE MAILED: 12/16/2003				

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/417,068</b>	Applicant(s) <b>Yoshida</b>
Examiner <b>Mark Wallerson</b>	Art Unit <b>2626</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Aug 18, 2003
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- 4)  Claim(s) 7-10 and 13-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 15-18 is/are allowed.
- 6)  Claim(s) 7-10, 13, and 14 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      6)  Other: \_\_\_\_\_

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### **Part III DETAILED ACTION**

#### *Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on **8/18/2003**.
2. This application has been reconsidered. Claims 7-10 and 13-18 are pending.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 7, 9, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Okutomi et al (Okutomi) (U. S. 6,211,972).

With respect to claims 7, 9, and 13, Okutomi discloses a facsimile control method for performing facsimile communication via the Internet (column 4, lines 1-12) comprising selecting either one of a first (transmission over telephone line L1) or a second (transmission over telephone line L2) communication mode; and causing a communication unit (figure 7) with a function for performing a first communication based on e-mail via the Internet (LAN) (column 7, lines 28-46) and a second facsimile communication not based on e-mail via the Internet (the second communication transmits facsimile data to a telephone number corresponding to an e-mail address) (column 7, lines 47-53) in accordance with an original size (number of sheets) (column 6, line 51 to column 7, line 60).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okutomi in view of Yasumoto (JP4 10032671A).

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With respect to claims 8, 10, and 14, Okutomi differs from claims 8, 10, and 14 in that he does not clearly disclose the first communication mode is selected for an original having an A4 size and the second communication mode is selected for an original having a B4 or A3 size.

Yasumoto discloses a facsimile system capable of receiving an electronic mail and fax document wherein when it is e-mail, an A4 original size is selected and when it is a facsimile document, a B4 original size is selected (figure 14). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Yasumoto to record an e-mail or a normal facsimile in different paper sizes in the system of Okutomi since both teach a fax system that can transmit and receive fax documents and E-mail messages. This combination will provide an improved fax system which can distinguish an electronic printed paper from a facsimile printed paper based on the size of the papers.

*Allowable Subject Matter*

7. Claims 15-18 are allowed.

*Response to Arguments*

8. Applicant's arguments with respect to claims 7-10 and 13-18 have been considered but are moot in view of the new ground(s) of rejection.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

MARK WALLERSON  
PRIMARY EXAMINER

MARK WALLERSON